

REMARKS/ARGUMENTS

In response to the Final Office Action mailed February 1, 2005, Applicants propose to amend their application and request reconsideration in view of the proposed amendments and the following remarks. In this Amendment, Claim 1 is proposed to be amended, no claims are added, and no claims are cancelled without prejudice so that Claims 1-7 are pending in the application. No new matter has been introduced.

Claims 1-7 were rejected 35 USC § 112, second paragraph. The claims have been amended to more particularly point out and distinctly claim the subject matter.

Claims 1-7 were rejected as being unpatentable over U.S. Patent No. 5,876,367 to Kaganov et al. (Kaganov) in view of U.S. Patent No. 6,726,701 to Gilson et al. (Gilson). This rejection is respectfully traversed.

The MPEP, in section 706.02(j), sets forth the basic criteria that must be met in order to establish a *prima facie* case of obviousness.

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d,488,20

USPQ2d 1438 (Fed.Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.”

Section 2143.03 of the MPEP clarifies certain criteria in section 706.02(j).

“To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1074). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d1596 (Fed. Cir. 1988).”

The present invention, as claimed in amended Claim 1, is directed to a cardiopulmonary bypass filter system that comprises a filter membrane having openings. The openings have variable diameters with respect to one another and the diameter of the openings range from about 20 to 300 microns. In addition, fibers are attached to the circumference of the openings to increase embolic capture.

Neither of the references, whether taken alone or in combination, discloses or even remotely suggests these extra fibers. The threads disclosed in Kaganov are the threads that make up the filter and not cilia type extra threads extending in from the circumference of the holes. Since not all of the features are suggested by the references, a *prima facie* case of obviousness has not been made. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

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Applicant would be grateful for the opportunity to conduct a telephone or in-person interview if the Examiner believes it would be helpful in disposing of the present case.

The Reply raises no new issues and places the application in form for allowance. Therefore, entry is proper and earnestly solicited.

Respectfully submitted,

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